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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/192,766	11/16/1998	JOHN F. BREEDIS	101.931	1189

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WIGGIN & DANA
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EXAMINER

IP, SIKYIN

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/192,766

Applicant(s)

BREEDIS ET AL.

Examiner

Sikyin Ip

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☒ Claim(s) 1 and 3-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1 and 3-12 are objected to because of the following informalities: The word "hom" in claim 1, line 10 is an apparent typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).
4. Claims 1, 3, and 6-12 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 5-311292 (PTO-1449, abstract and page 5, col. 7, sample No. 13 and 14) or JP 7126779 (PTO-1449, page 2, col. 1).
5. Claims 1, 3-4, and 6-12 are rejected under 35 U.S.C. § 103 as being

unpatentable over JP 06228684 (abstract).

6. Claims 1, 3-5, and 7-9 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 04231430 (abstract and Table 2) or JP 05059467 (abstract).

7. Claims 1 and 3-12 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 06179932 (abstract).

8. JP 5311292 disclose(s) the features including the claimed Cu base alloy compositions and Ni/P ratio (see abstract and col. 7, sample No. 13 and 14), and the intended electrical use (see translation page 15, lines 4-5) except for the electrical conductivity.

9. JP 7126779 disclose(s) the features including the claimed Cu base alloy compositions, electrical connector use (abstract), and electrical conductivity (translation page 19, Table 2) except for the Ni/P ratio.

10. JP 06228684 disclose(s) the features including the claimed Cu base alloy compositions and electrical connector use (abstract), except for electrical conductivity and the Ni/P ratio.

11. JP 04231430 disclose(s) the features including the claimed Cu base alloy compositions, electrical connector use (abstract), and electrical conductivity (translation page 7, Table 2) except for the Ni/P ratio.

12. JP 05059467 disclose(s) the features including the claimed Cu base alloy

compositions, electrical connector use (abstract), and electrical conductivity (translation page 14, col. 6, from right of Table 2) except for the Ni/P ratio.

13. JP 06179932 disclose(s) the features including the claimed Cu base alloy compositions, electrical connector use (abstract), and electrical conductivity (translation page 9, first col. From right of Table 1) except for the Ni/P ratio.

14. With respect to the Ni/P ratio that it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. *In re Austin, et al.*, 149 USPQ 685, 688.

15. With respect to the electrical conductivity, that the instant copper based alloy composition, intended use, and Ni/P ratio are overlapped by the cited JP 5311292 and JP 06228684 references; consequently, the properties as recited in the instant claims would have inherently possessed by the teachings of the cited references. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. Similar process can reasonably be expected to yield products which

inherently possess the same properties. In re Spade, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), In re DeBlauwe, 222 USPQ 191, and In re Wiegand, 86 USPQ 155 (CCPA 1950). In re Best, 195 USPQ, 430 and MPEP § 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977).”

16. The instant transitional expression “consisting essentially of” includes the optional alloying elements from the cited references. When applicant contends that modifying components in the reference composition are excluded by the recitation of “consisting essentially of” applicant has the burden of showing the basic and novel characteristic of his/her composition - i.e. a showing that the introduction of these components would materially change the characteristics of applicant's composition. In re De Lajarte, 337 F 2d 870, 143 USPQ 256 (CCPA 1964) and Ex parte Davis, et al., 80 USPQ 448, 450 (PTO Bd. App. 1948).

17. The expression “sufficient resistance to stress relaxation” in claim 1, lines 9-10 is defined in relative terms and reads on a minimal amount of resistance of stress

relaxation that required for prior arts' electrical connectors.

Response to Argument

18. Applicant's arguments filed November 17, 2003 have been fully considered but they are not persuasive.

19. Applicants argue that the Figure 1 and page 8, lines 207-210 in instant specification has shown the claimed Ni/P ratio is critical. But, Figure 1 fails to express Ni/P ratio to any claimed properties. Moreover, Figure 1 fails to show properties at the end-points of claimed Ni/P ratios.

20. Applicants argue that JP 05311292 broadly teaches Ni/P ratio from 5:1 to 50:1. But, said reference has disclosed Ni/P ratios in col. 5, samples No. 13 and 14 with Ni/P ratios at 5.4 and 7.4 respectively.

21. Applicants' argument as set forth in pages 5-6 of the instant remarks is noted. But, alloy 13 of JP 05311292 reference has shown the claimed Ni/P ratio is not critical and does not provide unexpected properties by itself. And there is no evidence found on record to substantiate applicants' position.

22. Applicants argue that JP 05311292 does not disclose the intended use. But, the claimed intended use of the claimed alloy does not lend patentability to the alloy. A mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable. See *In re Lemin*, 51 CCPA 942, 326

F.2d 437, 140 USPQ 273 (1964), *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951), *Ex parte Douros* 163 USPQ 667 (POBA), *In re Casey*, 152 USPQ 235 (CCPA 1967), and *In re Craige*, 188 F.2d 505, 89 USPQ 393 (CCPA 1951).

23. Applicants argue that JP 7-126779, JP 4-231430, JP 6-179932, and JP 6-228684 do not disclose the claimed Ni/P ratio. However, said references have Ni and P contents overlapped the claimed range. Furthermore, selecting a range in a known range by optimization for the best results is within ambit of ordinary skill artisan, see *In re Aller*, et al., 105 USPQ 233 and *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). Moreover, as are evident by JP5311292 samples No. 13 and 14 that the claimed Ni/P has no unexpected results. With respect to the intended use argument, the examiner reiterates the response as set forth above.

24. Applicants argue that Zn is not an essential alloying element in JP 5-059467. But, Zn has been taught by said reference. Under 35 USC § 103, a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests. *In re Lamberti*, 545 F.2d 747, 192 USPQ 278, 280 (CCPA 1976); *In re Simon*, 59 CCPA 1140, 461 F.2d 1387, 174 USPQ 114 (1972); and *In re Mills*, 470 F.2d 649, 176 USPQ 196 (CCPA 1972). *Ultradent Prods., Inc. v. Life-Like Cosmetics, Inc.*, 127 F.3d 1065, 1068, 44 USPQ2d 1336, 1339 (Fed. Cir. 1997) (error to construe prior art disclosure as limited to the preferred embodiment).

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25. Applicants' argument as set forth with respect to JP06-179932 is noted. But, the examiner reiterates the responses as set forth above.


Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
February 22, 2004